

REMARKS

Upon entry of the present amendment, claims 10-13 will be pending in the above identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, the amendment to claim 10 finds support at page 4, lines 18-23 and page 7, lines 5-6 and 18-27 of the originally filed specification.

Newly added claim 12 finds supporting disclosure at page 6, lines 9-13 of the originally filed specification, and claim 13 finds support at page 8, lines 21-26 of the originally filed specification.

Accordingly, entry of the instant amendment is respectfully requested at present.

***Claim Rejections Under 35 USC § 103(a)***

Claim 10 stands rejected under 35 USC § 103(a) as being obvious over Tao et al. (WO 99/60973) in view of Morman et al. (US 5,883,028), and further in view of Jordan et al., (US 2001/0031954). Claim 11 stands rejected under 35 USC § 103(a) over the same references further in view of McCormack et al. (WO 00/389015).

Each of the above rejections is respectfully traversed and reconsideration and withdraw thereof are respectfully requested based on the following considerations.

The Present Invention and Its Advantages

The present invention recited in amended claim 10 has the following claim elements (A) to (I):

- (A) An absorbent article comprises a liquid-permeable topsheet, a liquid-impermeable backsheet, and a liquid retentive absorbent member interposed between the topsheet and the backsheet,
- (B) The backsheet comprises a laminated sheet composed of a breathable film printed with a multicolor pattern, and
- (C) A first nonwoven material is superposed on the printed side of the film and a second nonwoven material is laminated on the first nonwoven material,
- (D) An elastic member is fixedly disposed between the first and second nonwoven materials,
- (E) A total basis weight which is a sum of a basis weight of the first nonwoven material and a basis weight of the second nonwoven material is 20 to 50 g/m<sup>2</sup>,
- (F) A total thickness which is a sum of a thickness of the first nonwoven material and a thickness of the second

nonwoven material before laminating the first and second nonwoven materials is 0.5 to 3.0 mm,

- (G) The printed area of the film has an L\* value of 10 to 93 and a C\* value of 20 to 120 as measured with a color difference meter,
- (H) A total light transmittance of the first and second nonwoven materials is 40 to 83%, and
- (I) Nonprinted background areas on the printed side of said breathable film have a b\* value of 0 to -5.

According to the absorbent article recited in amended claim 1, the following advantage (a) can be exhibited (*see page 13, lines 8-9 of the present specification*).

- (a) Both clearness of the multicolor printed pattern and texture or feel of the absorbent article are satisfied.

Distinctions Over the Cited Art References

Tao, WO 99/60973, is prior art referred to on page 1 of the present specification. It discloses a disposable diaper having a laminate sheet comprising a breathable film and a nonwoven material, in which the film is printed on its side laminated with the nonwoven material. The object of Tao is to prevent the background color of the background area of the film from yellowing.

Tao states that yellowing will reduce consumer acceptance. Tao discloses that a multicolor pattern is printed on a breathable film constituting a backsheet, and the film is laminated with the nonwoven material.

However, there is nothing in Tao to disclose or suggest that an L\* value and a C\* value in the printed area of the film fall within the ranges of each as defined in claim element (G). As described on page 1 of the specification, the object of Tao is to prevent the background color of the film from yellowing, which will reduce consumer acceptance. Tao uses a film whose b\* value is in a specific range to achieve the object. However, no consideration is given to satisfying both the clearness of the pattern, which can be seen through nonwoven material, and texture or feel of the diaper.

It is submitted that it would not have been obvious for a skilled person in the art to print the film so as to achieve the clearness of the printed pattern, which can be seen through nonwoven material. With intensive study, the inventors have found that the present invention has been achieved by (i) choosing L\*a\*b\* color system among various kinds of color systems including XYZ color system, L\*u\*V\* color system, Munsell system and Ostwald system, (ii) choosing only L\* value and C\* value of L\*a\*b\* color system which defines a\* value and b\* value in addition to L\* value and C\* value, and (iii) finding a specific range each of L\* value

and C\* value. These findings have been obtained with difficulties, which are beyond a matter of design of a skilled person in the art. Even if the problem to be solved is obvious, the means for solving the problem that has been achieved by the present invention is not rendered obvious from the disclosure of Tao.

Furthermore, as defined in claim element (C), the side of the film printed with the multicolor pattern is covered with the laminate of the first and second nonwoven materials. Due to this structure, the printed color tends to show uncleanness and blur compared with Tao. As defined in claim element (D), the elastic member is fixedly disposed between the first and second nonwoven materials, so that the printed pattern near the elastic member tends to become more unclear. In order to secure a clear printed pattern in this adverse condition, it is necessary to employ an L\* value and a C\* value as defined in claim element (G). In summary, the L\* value and C\* value as defined in claim element (G) are a specific value for a laminated sheet having an elastic member fixedly disposed between the two layers of nonwoven materials.

Good texture or feel of the absorbent article is another important feature of the present invention, in addition to the feature of clearness of the printed pattern, which can be seen through the nonwoven material. For obtaining this feature, it may be advantageous to increase the basis weight or the thickness of

nonwoven material thereby providing a cloth-like texture with the backsheet. However, the increased basis weight or the thickness would have a negative effect on the clearness of the printed pattern. Therefore, the present invention employs claim element (E) regarding the basis weight, claim element (F) regarding the thickness and claim element (H) regarding the total light transmittance of the non-woven material, thereby achieving both the clearness of the printed pattern and texture or feel of the absorbent article in a well-balanced manner.

Contrarily, while Tao discloses that a laminated sheet has a breathable film and a nonwoven material, in which the film is printed on its side laminated with the nonwoven material, Tao neither discloses nor suggests that an L\* value and a C\* value in the printed area of the film should fall within the ranges as each are defined in claim element (G), as discussed above. In particular, the teaching on page 5, lines 12-13 of Tao, "the most important parameter for the films of the present invention is the "b" value, teaches a skilled person in the art away from employing an L\* value and a C\* value. In addition, there is no disclosure or suggestion in Tao to use the first and second nonwoven materials or to fixedly dispose an elastic member between the first and second nonwoven materials. Tao is also silent about the basis weight, thickness and total light transmittance of nonwoven materials.

Satisfying both clearness of the printed pattern, which can be seen through nonwoven materials, and texture or feel of the absorbent article in a well-balanced manner, is neither disclosed nor suggested by Tao.

In view of the above discussion, it is submitted that the present invention is not rendered obvious by the disclosure and teachings of Tao.

Neither Morman nor Jordan et al. disclose the structure of a printed film, a first nonwoven material superposed thereon, and a second nonwoven material laminated on the first nonwoven material. Therefore, it is believed that the combination of Tao, Morman and Jordan et al. does not motivate one skilled in the art to reach the claim elements (A) to (I) of the present invention. Therefore, the present invention is not rendered obvious by these three cited art references.

The M.P.E.P. at § 2143.01 clearly teaches the need for motivation to arrive at the invention being claimed, when applying references in a 35 USC § 103(a) obviousness rejection:

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill

in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In addition to each of the above considerations, Applicants also submit that claim 11 is allowable based on its dependency from allowable claim 10, since the deficiencies of the references of Tao et al., Morman et al. and Jordan et al. are not cured by the disclosure of McCormack et al.

CONCLUSION

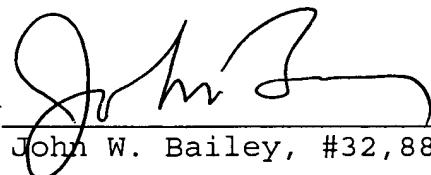
Based on amendments and remarks presented herein, the Examiner is respectfully requested to issue a notice of allowance clearly indicating that each of pending claims 10-13 are allowed and patentable under the provisions of title 35 of the United States Code.

In the event that there are any outstanding matters remaining in this application, the Examiner is invited to contact John W. Bailey (Reg. No. 32,881) at the telephone number indicated below, in order to expedite the present case towards allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 CFR §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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